IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

YOUNG-TAEK SUL

Serial No.:	10/550,197	Examiner:	WERNER, JONATHAN S.
Filed:	21 September 2005	Art Unit:	3732
For:	HELICAL IMPLANT		

RENEWED PETITION UNDER 37 CFR §1.181

Mail Stop: Petition
Office of Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to Decision on Petition mailed on 7 June 2010, entry and consideration of the following timely filed petition is respectfully requested. Applicant respectfully petitions from the Examiner's requirement in a final Office action (Paper No. 20070322) mailed on 10 April 2007 that Figure 6 be labeled as "Prior Art", and as reasons therefore, states that:

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Date: 8/9/10
I.D.: REB/YFM/mk

STATEMENT OF FACTS

1. On 10 April 2007, the Examiner mailed a final Office action (Paper No. 20070322). Paper No. 20070322 mentioned the requirement of labeling Figure 6 as "Prior Art."

2. On the 14th of May 2007, Applicant filed a *Petition Under 37 CFR §1.181* to seek reversal and withdrawal of the Examiner's requirement that Figure 6 as "Prior Art."

3. In a *Decision On Petition* dated on the 4th of December 2007, the Group Director dismissed Applicant's *Petition Under 37 CFR §1.181*.

4. On the 4th of February 2008, Applicant filed a *Renewed Petition Under 37 CFR §1.181* to seek reversal and withdrawal of the Examiner's requirement that Figure 6 as "Prior Art."

5. In a *Decision On Petition* dated on the 7th of June 2010, the Group Director dismissed Applicant's *Renewed Petition Under 37 CFR §1.181*.

ARGUMENTS AND/OR REMARKS

In the *Renewed Petition filed* on the 4th of February 2008, Applicant traversed the requirement in the final Office action of the 10th of April 2007 for designating Figure 6 of Applicant's drawings as "Prior Art" because the Applicant believes that Figure 6 is not "Prior Art" as that term is statutorily defined under 35 U.S.C. §103(a) by reference to the several paragraphs of 35 U.S.C. §102, and presented four arguments demonstrating that the Examiner's objection was incorrect, and requested review of the examiner's objection to the drawings under MPEP 608.02(g).

In the *Decision On Petition* dated on the 7th of June 2010, the Group Director found that the machine translation of Korean Patent Application 10-2003-0018745 filed on September 21, 2005 indicated FIG. 6 as "a conventional or prior art feature". Then, the Group Direction concluded that the Examiner's objection of FIG. 6 for failure to label as "prior art" is proper in accordance with MPEP §608.02(g).

Specifically, on pages 2-3 of the "Decision on Petition", the Group Direction stated:

> "With regard to the drawing objection in the August 4, 2006 Office action and again in the final Office action of Apr. 10, 2007, it must be noted and agreed that in the current patent application, nowhere does the applicant indicate Fig. 6 is a prior art feature."

This finding-of-fact set forth in the *Decision on Petition* is fully determinative of the issue of whether under U.S. law, FIG. 6 should be labeled as PRIOR ART, and whether concomitantly, does the Applicant make an explicit admission that FIG. 6 illustrates a prior art feature?

Inexplicably, the *Decision on Petition* digressed from its foregoing finding-of-fact under U.S. law by shifting from U.S. law, and continues by an extra-territorial application of the internal organic law of the Republic of Korea. Unlike 35 U.S.C. §102, the internal organic law of the Republic of Korea, contains no one year statutory "grace period" after a public use or a publication. Specifically, the *Decision on Petition* continued by reasoning that the certified Korean priority language patent application 10-2003-0018745 filed on the 21st of September 2005, and prepared in conformance with the internal organic law of the Republic of Korea,

"However, it should be noted that the certified copy of the Korean language patent application 10-2003-0018745 filed September 21, 2005 appears to indicate that Fig. 6 is a conventional or prior art feature. The Office has obtained a copy of machine translated Korean language patent application 10-2003-0018745 filed on September 21,2005. Under various headings of the machine translated Korean language patent application 10-2003-0018745, the English translation clearly indicates that Fig. 6 is a conventional and prior art feature. Therefore, the examiner's objection of Fig. 6 for failure to label as "prior art" is proper in accordance with MPEP § 608.02(g).

With regard to arguments that the word "conventional" does not mean "prior art" in the US patent laws and practices. This line of arguments is not persuasive because the issue here is a simple translation from Korean language to English language. The applicant should know the contents of his/her own Korean language patent application 10-2003-0018745. Under the heading of "The Technical Field to Which the Invention belongs and the Prior Art in that Filed" of the Korean language patent application, Fig. 6 is clearly explained as a conventional or prior art feature. Under the circumstances, in the alternative a new drawing of Fig. 6 labeled as "Conventional" would be acceptable to comply with the examiner's drawing objection."

Applicant respectfully disagrees with the Group Director because the Group Director's reliance on a foreign patent law is improper. No Court within these United States has ever authorized an extra-territorial application of the internal organic law of the Republic of Korea, or of any other sovereign state to determine whether the rights of an applicant, applying for a grant before an agency of the United States government, are to be determined by the internal organic laws

of a foreign kingdom, princedom or state. Applicant respectfully submits, that the U.S. Constitution makes an absolute prohibition against this application of the internal organic laws of the Republic of Korea to the issue.

Specifically, as evidenced from the Declaration/Oath, the Applicant is a citizen of Republic of Korea, and the Korean Patent Application 10-2003-0018745 relied upon by the Group Director in this *Decision* was prepared under the Korean Patent Law.

In the Korean Patent Application 10-2003-0018745, Figure 6 has been devised by the Applicant as a conventional art **under the Korean Patent Law** in order to illustrate Applicant's discovery of problems that Applicant had discovery to have plagued the art. By identifying deficiencies in the prior art and then addressing those deficiencies, Applicant completes the inventive process. As such, Applicant's effort to identify deficiencies or other undesirable features in the art, does **not** constitute "Prior Art" as that term is used under 35 USC §103, and defined by 35 USC §§102(a)-(g).

In addition, there is no showing that Figure 6 were known to anyone other than the Applicant ***in this country*** (i.e., the United States) nor is there a showing that Figure 6 were ***patented or published in this country or a foreign country*** except when published, or laid-open, in Applicant's Korean priority application Serial No. 10-2003-0018745 filed on 26 March 2003.

Therefore, the Group Director can not rely on a foreign publication published under foreign patent law to identify Figure 6 as "Prior Art" under the US Patent Law.

REMEDY REQUESTED

The Commissioner is respectfully requested to:

A. Withdraw the requirement for Applicant to label Figure 6 as "Prior Art";

B. Return the prosecution history to the Examiner to reprove any assertion that Figure 6 should be identified as "Prior Art"; and

C. Grant Applicant such other and further relief as justice may require.

Respectfully submitted,

/Robert E Bushnell/
Robert E. Bushnell
Attorney for Applicant
Reg. No.: 27,774

1522 "K" Street, N.W., Suite 300
Washington, D.C. 20005
Telephone: 202-408-9040

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